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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,921

09/20/2005

Mitsunori Nodono

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FOLEY AND LARDNER LLP  
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EXAMINER

HU, HENRY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

09/16/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,921	<b>Applicant(s)</b> NODONO, MITSUNORI	
	<b>Examiner</b> HENRY S. HU	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Election of April 29, 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2-14-2008, 12-20-2005 and 8-24-2009</u> .                     | 6) <input type="checkbox"/> Other: _____                          |



1. **New Examiner**. It is transferred from **Jonathan Crepeau** of art unit 1795. This Office Action is in response to **Election** along with its **Pre-Amendment** filed on April 29, 2009. Applicants have elected **Group I (Claims 1-5) with traverse**. However, **Re-Restriction requirement is found necessary by this Examiner**.

Examiner now **accepts Applicants' four drawing sheets with Figures 1-4** (a brief description is on page **4**). **Three IDS'** (3 pages total) have been received so far. With such a pre-amendment, only dependent Claim 3 is amended to remove multiple claim dependency, while no claim is cancelled or added. **Claims 1-12 with two independent claims (Claims 1 and 8)** are pending now. An action follows.

#### **DETAILED ACTION**

##### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121: It is noted that **two** independent claims are marked with an underline.

I. **Claims 1-7, drawn to a process of making a polymer electrolyte membrane (PEM) (Claim 1-5), the product made (Claim 6) and its application in fuel cell (Claim 7). Said process involves two sequential steps (A)-(B) as specified.**

II      **Claims 8-12**, drawn to **an apparatus** for producing a polymer electrolyte membrane.      Said apparatus comprises three means (A)-(C) as specified.

3.      The inventions are distinct, each from the others because of the following reasons:

**Inventions I and II** are unrelated each other.      Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).      In a very close examination, each group may comprise the same polymer electrolyte as specified in Group I, many other factors are indeed and routinely involved in the making or using as known in the art.      They are in different combination and may be prepared through different process and/or stayed on different form.

4.      For one instance, **Group I and Group II** are indeed each related to a fundamentally different process of making/means and are involved different steps (two steps versus three steps).      Group I involves coating and laminating, while Group II involves coating means, tension applying means and laminating mean.      Therefore the scope of the claims, i.e., the metes and boundaries are distinct.      It is noted that the product made (Claim 6) and its application in fuel cell (Claim 7) are both joined with previous elected process Group I (Claims 1-5).

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5. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. It is noted that no phone call was made to Attorney **Benjamin A. Berkowitz (reg. # 59,349, tel: 202 295-4620)** by the examiner due to the complexity on current situation. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Vasu Jagannathan, can be reached on (571) 272-1119. The **fax** number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peter D. Mulcahy/  
Primary Examiner, Art Unit 1796

/Henry S. Hu/  
Examiner, Art Unit 1796

September 11, 2009